II. REMARKS/ARGUMENTS

These Remarks are in response to the Office Action mailed August 3, 2005. No fee is due for the addition of any new claims.

Claims 1-56 were pending in the Application prior to the outstanding Office Action. The Office Action rejected claims 1-56.

As a preliminary matter, the examiner noted on page 2 of the office action that claims 1, 39, and 56 are independent claims. Applicant respectfully submits that claim 51 is independent, and that 56 is a dependent claim of claim 51. Applicant respectfully requests recognition of the correct claim characterization.

1. Claim Rejections Pursuant to 35 U.S.C. Section 101 (Utility)

The examiner rejected claims 1-50 on the grounds that the claimed invention is directed to non-statutory subject matter. Applicant respectfully disagrees.

Concerning Claim 1, the examiner indicated that the claim language "merely describes a computer program per se." and as such there is a question "as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine, which would result in a practical application producing a concrete, useful and tangible result" as required by section 101. Office Action at 3.

The examiner suggested that section 101 would be satisfied if the claim language taught the first code and the second code residing in memory/hardware, wherein the codes produced a tangible result.

Applicant responds that claim 1 has been amended to indicate that the first code and the second code claimed in claim 1 reside in a processor-readable storage medium and when executed by the processor, produce a tangible result, namely, detecting an annotation in a document; detecting proximity of the annotation to an anchor; and processing of any annotated anchor. Support for this amendment can be found, by way of example, at paragraphs [0020], [0046]-[0050], [0053]-[0056] of the specification.

Because Claim 1 as amended satisfies the requirements of section 101, Applicant respectfully requests reconsideration of the rejection.

Concerning Claim 39, the examiner raised essentially the same rejection as for Claim 1. Applicant has amended claim 39, a method claim, so that it follows the rule recited in the MPEP section 2106 (IV)(B)(2)(b)(ii), which states:

> For subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. [citations omitted.] A claim is limited to a practical application when the method, as claimed produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful.

In particular, Claim 39 as amended recites a processing step that "produces a concrete, tangible and useful result," namely, displaying a data structure of annotated anchors. Reconsideration of the rejection is requested.

Concerning Claims 2-38, which depend from Claim 1, the examiner rejected these claims as not adding any limitations that would render the claims statutory pursuant to section 101. Applicant respectfully disagrees based on the claim 1 as amended, and on that basis requests reconsideration.

Concerning Claims 40-50, which depend from claim 39, the examiner rejected these claims as not adding any limitations that would render the claims statutory pursuant to section 101. Applicant respectfully disagrees based on the claim 39 as amended, and on that basis requests reconsideration.

2. **Claim Rejections Pursuant to 35 U.S.C. § 102(e)**

The examiner rejected claims 1-9, 14, 15, 24, 26, 38-40, 42-43, 51, and 53-54 as anticipated by Carro (U.S. Pub. No. 2001/0056439 A1, hereinafter "Carro"), pursuant to 35 U.S.C. section 102(e) ("102(e)"). All three independent claims (1, 39, and 51) are subject to the anticipation rejection. Applicant respectfully disagrees.

Carro discloses a "system and method for selecting and accessing multimedia information and/or services . . . by touching with a finger items *marked on a physical*

document or on any other physical surface." (Carro, Abstract [emphasis added]). In other words, Carro discloses "a method and system for creating hyperlinks *from physical documents (manuscripts or printed documents)* . . ." *Id.* at ¶ [0001] (emphasis added).

In contrast, the present invention teaches a method and system for supporting hypertext navigation by detecting and processing annotated *hypertext anchors in documents stored in a processor-readable medium.* Claims 1, 39, and 51 have been amended to teach explicitly this aspect of the present invention. Support for the specified amendments is found in the written description at paragraph [0039], which discloses the definition of "document" as follows:

> A "document" as described herein, may be any representation of thoughts by means of conventional marks or symbols. For example, a document may be an electronic document, such as a .pdf, .doc, .wpd, .rtf, html, or any other type of similar electronic file. Additionally, a document may be a video, still image, or picture. In general, a document may be any graphical representation which is viewable by a reader.

Further support is found in the specification at paragraph [0045], which describes an embodiment of the computer system of the invention, which comprises a storage device.

> The storage device 260 stores a document 222 which is displayable on display 240. The input/output interface 225 communicates with any number of conventional input/output devices 224 such as a mouse 226, a keyboard 228 and/or a pen-based device 230. A reader manipulates the input/output device to annotate the document 222 while it is displayed on display 240.

From the foregoing, as well as other disclosures in the specification of the present application, the documents contemplated by the embodiments of the present invention are documents stored in a processor-readable medium, and are not physical documents as taught in Carro. Because Carro fails to teach at least this limitation of the present invention, Carro cannot anticipate claims 1, 39, and 51 of the present invention pursuant to section 102(e). Because claims 2-9, 14-15, 24, 26, and 38 depend directly or indirectly from claim 1, these

claims are not anticipated by Carro. Because claims 40, 42, and 43 depend directly or indirectly from claim 39, these claims cannot be anticipated by Carro. Because claims 53-54 depend directly or indirectly from claim 51, these claims cannot be anticipated by Carro.

Moreover, Carro does not teach or disclose "a first code in the processor-readable storage medium for locating an annotation in the document;" as recited in claim 1 as amended. For at least this reason, claim 1 as amended is not anticipated over Carro, and all claims depending from claim 1 therefore are not anticipated by Carro.

Further, Carro does not teach or disclose "a second code in the processor-readable medium for detecting, proximate to or within the annotation, the presence of an anchor, . . ." as recited in claim 1 as amended. Similarly, claim 51 as amended claims "An apparatus for detecting at least one annotated anchor in a document stored in a processor-readable storage medium, . . .". As discussed above, the "anchors" referred to and acted upon, as disclosed in the present invention, are not found in physical documents, as in Carro, but rather, in documents stored in a processor-readable medium. Carro therefore does not teach "a second code in the processor-readable storage medium for detecting, proximate to or within the annotation, the presence of an anchor, . . ."; no such second code is needed since the anchor in Carro is on a physical document. Accordingly, Carro cannot anticipate the present invention.

For at least the foregoing reasons, reconsideration of the rejection based upon anticipation therefore respectfully is requested.

3. **Claim Rejections Pursuant to 35 U.S.C. § 103(a)**

The examiner rejected only dependent claims as obvious pursuant to section 103(a). Because the examiner did not reject any of the independent claims as obvious, none of the dependent claims can be obvious. Accordingly, Applicant respectfully submits that all claims are patentable over the cited art. Nevertheless, Applicant addresses each of the section 103(a) rejections below.

Claims 10, 16-20, 41, and 52:

The examiner rejected the above-referenced claims pursuant to 35 U.S.C. section 103(a) (hereinafter "103(a)") as being obvious over Carro as applied to claims 7, 39, and 51,

and further in view of Wright, U.S. Pub. No. 2002/0091679 A1 ("Wright"). Office Action at 7. Applicant respectfully disagrees.

With regard to dependent claims 10, 11, 16-20, 41, 52, neither Wright nor Carro, alone or in combination, teaches or discloses each of the limitations of the independent claims 1, 39, and 51. Accordingly, the cited art cannot render obvious the currently-rejected dependent claims.

In particular, but without limitation, neither Carro (the above remarks about which are incorporated herein in full) nor Wright teaches or discloses any of the following: (a) "a first code in the processor-readable storage medium for locating an annotation in the document; and, a second code in the processor-readable storage medium for detecting, proximate to or within the annotation, the presence of an anchor, wherein the processor-readable storage medium communicates the first code and the second code to a processor to detect the annotated anchor in the document and to perform at least one process on the annotated anchor," as claimed in claim 1 as amended; (b) "processing the annotated anchor wherein the processing step further comprises adding the annotated anchor to a data structure of annotated anchors . . ." as claimed in claim 39 as amended; or (c) code to "detect, proximate to or within each annotation, the presence of an anchor; and generate a data structure including each annotated anchor" as claimed in claim 51 as amended.

Wright merely discloses a method for displaying search result information wherein a search identifies objects, and at least one of the objects has links to another object, *i.e.*, a link target. The links among the different objects can be displayed. *See, e.g.*, Wright ¶ [0009]. While Wright discloses that "one or more objects of the search" can be "annotated," Wright ¶ [0012], Wright *does not* disclose annotating the anchor (or in Wright's terminology, annotating the "link") and then detecting annotations in anchors/links to carry out a process on such annotated link, as per the independent claims 1, 10, and 51 of the present application. Likewise, Carro does not disclose or teach this limitation. Carro teaches "accessing multimedia information" by "touching with a finger items marked on a physical document or on any other physical surface." Carro, Abstract.

Because neither Carro nor Wright disclose each of the limitations of the independent claims, none of the dependent claims rejected by the examiner can be obvious in view of Carro and Wright. Accordingly, Applicant respectfully requests reconsideration of the obviousness rejection.

Claims 11-13:

The examiner rejected claims 11-13 as obvious over Carro and Sundaresan (U.S. Pat. No. 6,651,058, "Sundaresan"). Office Action at 10-11. Applicant respectfully disagrees because neither reference, alone or in combination, teaches each limitation of the independent claims of the present application and therefore, neither reference alone or in combination teaches each limitation of the above-referenced dependent claims.

In particular, but without limitation, neither Carro nor Sundaresan teaches or discloses "a first code in the processor-readable storage medium for locating an annotation in the document; and, a second code in the processor-readable storage medium for detecting, proximate to or within the annotation, the presence of an anchor, wherein the processor-readable storage medium communicates the first code and the second code to a processor to detect the annotated anchor in the document and to perform at least one process on the annotated anchor," as claimed in claim 1 as amended.

The remarks relating to Carro are incorporated herein in full, and Carro does not teach these limitations. Likewise, Sundaresan does not teach these limitations. Sundaresan merely teaches a computer program that mines large databases for terminology relevant to a given topic. Sundaresan Col. 3, ll. 33-40. Nothing in Sundaresan discloses detecting annotated anchors and processing annotated anchors. Because neither Sundaresan nor Carro, alone or in combination teaches or discloses each limitation of claim 1, dependent claims 11-13 cannot be obvious over the cited art, and reconsideration respectfully is requested.

Claim 21:

The examiner rejected claim 21 as obvious over Carro in view of Wright and in further view of Sundaresan. Office Action at 11. Applicant respectfully disagrees for the reasons set forth above, *i.e.*, that none of the references alone or in combination teach each of the limitations of claim 1. Reconsideration of the rejection is requested.

Claims 22-23:

The examiner rejected claims 22-23 as obvious over Carro and Wright and in further view of Ingram (U.S. Pat. Pub. No. 2002/0052890, "Ingram"). Office Action at 12-13. Applicant respectfully disagrees. Claims 22-23 depend indirectly from claim 1. As set forth above, and as incorporated herein in full, neither Carro nor Wright teach or disclose each limitation of claim 1 of the present application. Ingram too fails to add sufficient limitations so as to teach all of the limitations of claim 1.

Ingram relates to software that enhances hyperlinks. In particular, Ingram discloses an enhanced hyperlink and method for providing an enhanced hyperlink. Ingram further discloses that the invention permits the user to interact with a hyperlink in a variety of ways without necessarily having to open and/or follow the hyperlink. Ingram ¶ [0003]. In one embodiment, Ingram teaches keeping a reference "anchored" or "docked" to the computer screen while the user visits other hyperlinked media. Ingram ¶ [0041]. "Link enhancements" may be selected with a toolbar that appears when a cursor passes over the hyperlink. *See, e.g.*, Ingram ¶ [0047]. No annotation of links (or "anchors," in the terminology of the present application) are created by the user, and there is no code identifying annotated links/anchors for further processing, as taught in claim 1 of the present application.

Accordingly, the cited art, either each reference alone or in combination, teaches each limitation of claim 1 as amended of the present application. Reconsideration of the rejection respectfully is requested.

Claims 25, 27, 31, 33, 36-37, 45, and 48-50:

The examiner rejected the above-referenced dependent claims as obvious over Carro and Ingram. Office Action at 13-17. Applicant respectfully disagrees for the reasons stated above in connection with those references. Because the independent claims are not obvious over the cited art, the dependent claims also are patentable as non-obvious over the cited art. Reconsideration respectfully is requested.

Claims 28, 30, 44, and 55:

The examiner rejected the above-referenced dependent claims as obvious over Carro and in further view of Bays (U.S. Pat. Pub. No. 2003/0018632 A1, "Bays"). Office Action at

17-18. Applicant respectfully disagrees. Neither reference, alone or in combination, teaches every element of each independent claim.

The above remarks with regard to Carro are incorporated herein in full. Likewise, Bays does not disclose the limitations of independent claims 1, 39, and 51 of the present application. The present application teaches an embodiment that is, according to claim 1, "A system for detecting an annotated anchor in a document stored in a processor-readable storage medium . . .". An "anchor" is defined in the specification as:

> any perceivable manifestation of a link or reference to another document or to another portion of the current document. An anchor may be explicit, such as a hyperlink in a web page, or it may be implicitly defined, such as by the grammar one uses to identify documents in certain forms or citations.

Specification ¶ [0042]. It is of interest here that the present application teaches annotating "links or references . . ." Bays does not.

In contrast, Bays defines an "annotatable data item (i.e., the subsection of database material that can be annotated)" as:

> any entity referenced by an index (e.g., an object identifier) or any attribute or subcomponent of such an entity, or any arbitrary set of such items. Examples include a table such as a relational table or spreadsheet, a view such as a relational view, a row within a table, a cell within a table (i.e., the intersection of a column and a row), a column within a table, an object, an attribute of an object, a set of rows or columns from one table, or a set of rows from different tables.

Bays ¶ [0013].

At least because the present application annotates anchors, which are different than the "annotatable data items" disclosed in Bays, that reference does not disclose the limitations of claim 1 as amended, in particular, "a second code in the processor-readable storage medium for detecting, proximate to or within the annotation, the presence of an anchor . . .". Similarly, Bays together with Carro cannot render obvious claim 39 as amended, at least because neither reference teaches step (c): "processing the annotated anchor wherein the processing step

further comprises adding the annotated anchor to a data structure of annotated anchors; and displaying the data structure of the annotated data anchors . . .". Also, Bays together with Carro cannot render obvious claim 51 as amended, at least because the cited art does not teach "processor-readable program code for programming the apparatus to: [...] detect, proximate to or within each annotation, the presence of an anchor . . .".

Because the cited art does not render obvious independent claims 1, 39, and 51, the above-referenced dependent claims are not obvious over the cited art. Reconsideration of the rejection respectfully is requested.

Claim 29:

The examiner rejected claim 29 pursuant to section 103(a) as unpatentable over Carro in view of Bays and in further view of Stern (U.S. Pat. No. 6,572,661 "Stern"). Office Action at 18. Applicant respectfully disagrees because none of the references, alone or in combination, teach each element of independent claim 1 of the present application.

Applicant's above remarks regarding Carro and Bays are incorporated herein in full. Stern together with Carro does not disclose the limitations of independent claim 1 from which claim 29 depends. In particular, the present application discloses a system for detecting annotated anchors where annotations are made to existing anchors in documents. In contrast, the reverse happens in Bays. Bays discloses an apparatus and method where anchors and links are inserted after annotations are created to a software code. *See* Col. 5, ll. 22-34. Bays discloses an invention relating to "text-based code walk-through," which is essentially a series of explanatory "annotations" of software code for training engineers who use the software code. Bays Col. 1, ll. 11-55. The apparatus and method of Bays allows a descriptive annotation corresponding to a section of code to be moved along with the pertinent section of code as the code is revised, even if the pertinent section of the code is changed and no longer matches exactly the previously annotated code. *Id.*, Col. 1, ll. 43-55. In other words, Bays teaches inserting links/anchors between annotations and source code in a manner that allows them to be updated. Bays does not teach the limitations of claim 1 and amended, *i.e.*, "a second code . . . for detecting, proximate to or within the annotation, the presence of an anchor . . .".

In light of the foregoing, claim 29 is not obvious over the cited art, and is patentable. Reconsideration of the rejection respectfully is requested.

Claim 32:

The examiner rejected claim 32 as obvious pursuant to section 103(a) over Carro in view of Ingram and in further view of Stern. Office Action at 19. The above remarks as to each of these references is incorporated herein in full. None of the cited art, alone or in combination, teaches each of the limitations of independent claim 31 as amended. Accordingly, dependent claim 32 cannot be obvious over the cited art. Applicant respectfully requests reconsideration of the rejection.

Claims 34-35, 46-47, and 56:

The examiner rejected the above-referenced dependent claims as obvious pursuant to section 103(a) over Carro and in further view of Ingram and Bays. Office Action at 20. The above remarks as to each of these references is incorporated herein in full. None of the cited art, alone or in combination, teaches each of the limitations of independent claim 31 as amended, or independent claim 51 as amended. Each of the above-referenced claims depend from these independent claims. Because the independent claims are not obvious, their dependent claims cannot be obvious over the cited art. Accordingly, Applicant respectfully requests reconsideration of the rejections.

III. CONCLUSION

In light of the above, it is respectfully submitted that all claims should be allowable, and a Notice of Allowance is requested. The examiner is respectfully requested to telephone the undersigned if she can assist in any way in expediting issuance of the patent.

Enclosed is a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.136 for extending the time to respond up to and including today, December 5, 2005.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Dated: Dec 5, 2005

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